

### III. REMARKS

Claims 1,2,4, and 6-11 are amended to clarify what is intended to be protected in this application. Claims 28 and 29 have been added to include claim categories to which the Applicant is entitled. No new matter is presented. Claims 1-29 are presented for further consideration. Applicant has considered the Examiner's comments set forth in the Office Action mailed December 26, 2007 and responds in detail below. Reconsideration of the application is respectfully requested in view of the following remarks.

Applicant has amended the claims to correct inconsistencies in the claims and overcome the rejection based on 35USC112.

Claims 1,2,10,11, 18 and 25 stand rejected under 35USC103(a) on the basis of the combined teaching of the cited reference Gorsuch, U.S. Patent No. 6,526,034 in view of the reference Sainton, et al, U.S. Patent No. RE38,787. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch and Sainton does not render claims 1,2,10 and 11, 18, and 25 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the following features of independent claim 1:

**“transmitting a second service request from the mobile station to a second network in response to the data transmission service not being providable substantially in accordance with the first data transmission service request and the terminal not being reachable via the first network.”**

Independent claims , 12, 18, 21, 25, and new claim 28 contain equivalent language.

The Examiner acknowledges that reference Gorsuch fails to disclose or suggest this feature. To remedy this deficiency in the teaching of Gorsuch, the Examiner cites the teaching of Sainton.

The Examiner refers to figure 6b of the reference Sainton and also to claim 42. Figure 6b in particular involves a choice between a cordless land line system and a cellular network. The choice is determined by accessibility of the cordless land line system, if the user device is within range of the cordless system, then the cordless system is used. If the user device is out of range of the cordless system, but within range of a cellular system, the cellular system is accessed. There is no determination based on the type or destination of a particular service request, the process of selection in Sainton is based solely on the location of the originating device. In reality Sainton does not involve a selection of networks, but a selection of modes of operation, namely cordless land line or cellular. The Examiner’s reference to claim 42 is not understood, since it refers to a different embodiment of Sainton than that of figure 6b. In the embodiment of claim 42 a wireless service network may access the radio spectrum of another wireless service when increased demand needs to be served. This is a borrowing of radio frequencies not a use of alternative networks.

The teaching of Sainton therefore fails to remedy the deficiencies of Gorsuch as acknowledged by the Examiner. As a result the combined teaching of Gorsuch and Sainton fails to support the rejection of the independent claims of this application based on obviousness. These grounds apply equally to the rejected dependent claims, all of which, by dependency, have the limitations described in the independent claims

Claims 3, 13, and 19 are rejected, under 35USC103(a), based on the combined teaching of Gorsuch and Sinton and further in view of Roberts, U.S. Patent No. 7,181,201. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch, Sinton and Roberts does not render claims 3, 13, and 19 obvious because it fails to teach or otherwise suggest each and every limitation of the claims. It is well settled that in order to establish a prima facie case for obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, without reference to the disclosure of this application. (MPEP Section 2142) ***In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria."**

In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1,12. 18, 21, 25, and 28 for the reasons indicated above. In addition, the Examiner applies the combined teaching of the references Gorsuch and Sinton as indicated above, but further acknowledges that this combined teaching fails to disclose wherein the mobile station checks whether the terminal belongs to the first network and cites the reference Roberts to remedy this deficiency.

The reference Roberts involves a system for routing a call to a called party's landline or wireless communication unit based on the availability of the called party's wireless communication unit. (see abstract) This is similar to the embodiment of Sinton in which the choice is based on accessibility of the calling party's multi-modal device, however, in Roberts, the selection is based on the accessibility of the called party's wireless device. The teaching of Roberts, therefore fails to remedy the deficiencies of the combined teaching of Gorsuch and Sinton. The system in Roberts automatically routes the call. There is no checking of the first service request and there is no transmitting of a second request by the caller to a second network, if the first service

cannot be fulfilled in the first network. The combined teaching of Gorsuch and Sainton in view of Roberts therefore, fails to render claims 3, 13, and 19 obvious.

Claims 4-9, 14-16, and 20 are rejected under 35USC103(a) based on the combined teaching of Gorsuch and Sainton and further in view of McCanne, U.S. Patent No. 6901445. This rejection is traversed on the following grounds:

The combined teaching of Gorsuch, Sainton and McCanne does not render claims 4-9, 14-16, and 20 obvious because it fails to teach or otherwise suggest each and every limitation of the claims.

In particular the combined teaching fails to disclose or suggest the claimed features of amended independent claims 1, 12, 18, 21, 25, and 28 for the reasons indicated above. In addition, the Examiner applies the combined teaching of the references Gorsuch and Sainton as indicated above, but further acknowledges that this combined teaching fails to disclose wherein the first or local network sends a message to the mobile station indicating that the data transmission service request cannot be fulfilled in the first network. To remedy this deficiency the Examiner has cited the reference McCanne.

McCanne describes a network set up by an Internet service provider to facilitate the handling of a service request by the server of the service provider. It does not involve multiple networks, but is contained solely within the Internet. In McCanne a virtual overlay distribution network is established online consisting of a cluster of service nodes established at internet location by a service provider. These nodes act as alternative gateways to the content of the service provider to avoid overloading the system during excessive traffic. The operation of this is described at column 12, lines 17-22 as follows

**"Under this configuration, a client request 510 from an arbitrary host 512 in the Internet 508 is routed to the nearest ARN 514 using proximity-based anycast routing. The ARN 514 redirects the client (path 516) to a candidate service node 518 (path 520) using the range of techniques described herein."**

The Examiner indicates that, based on McCanne, it would be obvious to modify the combined teaching of Gorsuch and Sainton to include sending a message indicating a service is not available and where a service request should be retransmitted. According to the above, McCanne "redirects" a client request to an alternative gateway node based on capacity of a particular node. There are no messages sent back to the client nor is there a retransmission of the request by the client. McCanne does not relate to a selection of a communication network. It is not clear, just how a person skilled in the art would apply the disclosure of McCanne in the context of the combined teaching of Gorsuch and Sainton, and further, the Examiner's suggested motivation would have no application to the problem to which the subject application is directed. The context of the disclosure of McCanne is described succinctly at column 6, lines 52-56, as follows:

**"A collection of internal IP routers 110 interconnected with communications links 111 provide connectivity among users within an ISP. Specialized border routers 112 situated at the exchange points forward non-local traffic into and out of the ISP."(emphasis added)**

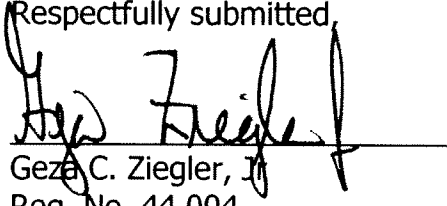
The disclosure of McCanne therefore, does not remedy the deficiencies of the combined teaching of Gorsuch and Sainton and as a result the combined teaching of Gorsuch, Sainton, and McCanne fails to support the rejection of claims 4-9, 14-16, and 20 based on obviousness.

All of the above grounds are equally applicable to new claims 28 and 29.

For all of the above reasons, it is respectfully submitted that all of the claims now present in the application are clearly novel and patentable over the prior art of record, and are in proper form for allowance. Accordingly, favorable reconsideration and allowance is respectfully requested. Should any unresolved issues remain, the Examiner is invited to call Applicants' attorney at the telephone number indicated below.

The Commissioner is hereby authorized to charge payment of \$100 for two additional total claims, \$210 for one additional independent claim and for any other fees associated with this communication or credit any over payment to Deposit Account No. 16-1350.

Respectfully submitted,

  
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Date

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